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10/23/01

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/364,731 07/30/99 KATZ

R 244/165

EXAMINER

WM01/1023

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WOO, S

ART UNIT	PAPER NUMBER
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2643

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DATE MAILED:

10/23/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

TS

Office Action Summary

Application No.
09/364,731

Applicant
Katz

Examiner
Stella Woo

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on Aug 17, 2001

2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) 29-48 is/are pending in the application

4a) Of the above, claim(s) _____ is/are withdrawn from consideration

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) 29-48 is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claims _____ are subject to restriction and/or election requirements

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.

12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

a) ☐ All b) ☐ Some* c) ☐ None of:

1. ☐ Certified copies of the priority documents have been received.

2. ☐ Certified copies of the priority documents have been received in Application No. _____.

3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

15) ☐ Notice of References Cited (PTO-892)

18) ☐ Interview Summary (PTO-413) Paper No(s). _____

16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

19) ☐ Notice of Informal Patent Application (PTO-152)

17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____

20) ☐ Other:

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DETAILED ACTION

1. The request filed on August 13, 2001 for a Continued Prosecution Application (CPA) under 37 CFR 1.53(d) based on parent Application No. 09/364,731 is acceptable and a CPA has been established. An action on the CPA follows.

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 29-48 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor, at the time the application was filed, had possession of the claimed invention.

Claims 29-37 recite a "telephone system of a type controllable by cards" and claim 38 recites a "method of handling telephone calls by use of cards." However, applicant's specification contains no teaching or suggestion of using "cards" in the manner recited in the claims. A card which controls a telephone system or handles telephone calls is used to enable a caller to place long distance calls over any phone and to charge the call to the account of the accountholder. The card authorization takes place at the telephone switching facility such that the call is not completed through the telephone network unless certain conditions are met. In contrast, applicant's specification describes the use of a credit card to authorize a transaction, such as mail order transaction or lottery participation, which takes place over an already completed telephone

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connection. A card for controlling a telephone system or handling telephone calls, as in the travel card of Marshall and as defined by the present claims, is used to authorize telephone call completion between a caller and a desired second party. The credit card or lottery ticket of the applicant is used to authorize a mail order transaction or participation in a lottery; calls are completed to applicant's telephone-interface system without any prior qualification based on the credit card or lottery identification data. Therefore, applicant's credit card or lottery ticket cannot be considered as a "card" as defined by the claims, which carries out a specific function in the telephony art.

Claims 29-37, 39-47 recite a "switching computer means being capable of disallowing completion of a call through the switching station if it is determined...that the call is not placed by a caller in good standing." Applicant's specification fails to provide support for this feature. In applicant's system, a caller dials the telephone number and is coupled by the communication facility through the ACD, interface and switch to a select processor. It is only after the call has been completed from the caller through the switching facilities to the select processor that the caller is determined as being one of good standing (page 12, line 14 - page 13, line 27; page 20, line 24 - page 22, line 35). If the caller is not one in good standing, the completed call is terminated (page 13, lines 28-31). Therefore, applicant's specification does not provide support for the "switching computer means being capable of disallowing completion of a call through the switching station if it is determined...that the call is not placed by a caller in good standing" as recited in claims 29-37, 39-47 since in applicant's system, the call is completed through the

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switching facilities (communication facility C, ACD, switch 21) irrespective of the caller's standing.

Claims 38 and 48 recite "preventing connection of telephone calls if validation determines the call is not made by a caller in good standing." Applicant's specification fails to provide support for this feature. In applicant's system, a caller dials the telephone number and is coupled by the communication facility through the ACD, interface and switch to a select processor. It is only after the call has been completed from the caller through the switching facilities to the select processor that the caller is determined as being one of good standing (page 12, line 14 - page 13, line 27; page 20, line 24 - page 22, line 35). If the caller is not one in good standing, the completed call is terminated (page 13, lines 28-31). Therefore, applicant's specification does not provide support for the step of "preventing connection of telephone calls if validation determines the call is not made by a caller in good standing."

Applicant's disclosure fails to provide support for the voice response device which is able to "make a call through the telephone system," "prevent a caller using a card to make a call through the telephone system," "leave a message for at least one subsequent caller using a card to make a call through the telephone system," and "permit a caller using a card to make a call through the telephone system to be automatically rerouted to a call number supplied to the system by a card customer" as recited in claims 30 and 40.

Applicant's disclosure fails to provide support for performing a "repeated failed attempts determination" and "preventing repeated attempts to enter the telephone system from a particular

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dial-up communication source by using a series of invalid personal identification numbers with a predetermined period of time” as recited in claims 31 and 41. Applicant’s system provides for a use-rate calculator for determining and limiting the number of successful uses by a caller, not the number of failed attempts.

Applicant’s disclosure does not provide support for “a data storage server means...capable of access by card customers of the telephone system to provide current billing information to card customers” as recited in claims 32 and 42 or “a voice response means being...capable of providing an oral report of current account status to card users” as recited in claims 33 and 43.

4. Claims 29-48 of this application are asserted by applicant to correspond to claims of U.S. Patent No. 5,790,636.

The examiner does not consider these claims to be directed to the same invention as that of U.S. Patent No. 5,790,636 because it does not contain all the material limitations of the patent claim as required by 35 USC 135 (b), namely, the use of a travel card for controlling the telephone system. Accordingly, an interference cannot be initiated based upon these claims.

5. Claims 29-48 of this application has been essentially copied by the applicant from U. S. Patent No. 5,790,636. These claims are not patentable to the applicant because they are not supported by applicant’s original disclosure.

An interference cannot be initiated since a prerequisite for interference under 37 CFR 1.606 is that the claim be patentable to the applicant subject to a judgement in the interference.

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6. Applicant's arguments filed November 17, 2000 and repeated in the response filed August 17, 2001 have been fully considered but they are not persuasive.

Applicant argues that "it is not important whether a card is called a 'travel' card or by any other name...as long as use of the card is carried out in a similar way." The examiner contends that the card in applicant's disclosure is not used in the same way as a card for controlling a telephone system as recited in the claims. The card in applicant's system is used to participate in a lottery or mail-order operation, the authorization (based on call data including ANI and a personal identification number as recited in independent claims 29, 38, 39, 48) taking place after the caller has been connected through the telephone network with a voice generator at the processing system P1 (page 18, line 31 - page 22, line 29). In contradistinction, a card for handling telephone calls is used by a caller to place a call from any telephone to a second party, the authorization taking place at the telephone switching station before the call is completed through the telephone network.

Applicant refers to page 13 of his specification as providing support for a "switching computer means being capable of disallowing completion of a call through the switching station if it is determined...that the call is not placed by a caller of good standing." Claims 29-48 require that the switching computer means determine whether or not a caller is in good standing based on the processing of call data which includes both automatic number identification and a personal identification number. Page 13 of applicant's specification describes the testing of the caller's telephone number only, not telephone number plus personal identification number as required by

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the claims. Moreover, applicant's system does not disallow completion of a call through the switching station. Rather, applicant's system disallows participation by a caller in a health-related statistical analysis, lottery or mail-order operation. In applicant's system, a caller places a call which is completed through the public telephone network to a voice generator in applicant's processing system P1 with which the caller interacts to provide a personal identification number (page 18, line 31 - page 22, line 29). It is after the call is connected with applicant's processing system that qualification takes place. Therefore, applicant's system does not teach a "switching computer means capable of disallowing completion of a call through the switching station if determined from processing of call data and additional parameter by the switching computer that the call is not placed in good standing."

Regarding the limitations of claims 30 and 40 which recite a voice response device which is able to "make a call through the telephone system," "prevent a caller using a travel card to make a call through the telephone system," "leave a message for at least one subsequent caller using a travel card to make a call through the telephone system," and "permit a caller using a travel card to make a call through the telephone system to be automatically rerouted to a call number supplied to the system by a travel card customer," applicant argues that his interface 20 is "capable of performing the above-stated functions." However, applicant does not point out where in his specification these functions are provided for his specification. The examiner maintains that the specification finds no support for the above-stated functions.

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Regarding the limitations of claims 31 and 41 which recite performing a “repeated failed attempts determination” and “preventing repeated attempts to enter the telephone system from a particular dial-up communication source by using a series of invalid personal identification numbers with a predetermined period of time,” applicant points to page 13 of his specification where his system determines if the caller has entered a proper telephone number or not. However, the personal identification number of dependent claims 31 and 41 is not the caller’s telephone number (note independent claims 29 and 39 which state that call data includes automatic number identification and a personal identification number). Moreover, by definition, a personal identification number is a number specific to an individual, not a telephone station.

Regarding the limitations of claims 32 and 42 which recite “a data storage server means...capable of access by travel card customers of the telephone system to provide current billing information to travel card customers” and the limitations of claims 33 and 43 which recite “a voice response means being...capable of providing an oral report of current account status to travel card users,” applicant points to page 40, lines 28-33. However, this section merely describes a voice generator informing a game participant whether or not his answers are correct. It does not provide support for any of the above-stated functions.

7. Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

Washington, D.C. 20231

or faxed to:

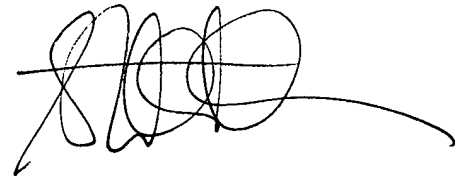
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(703) 872-9314.

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington. VA., Sixth Floor (Receptionist).

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stella Woo whose telephone number is (703) 305-4395 and can normally be reached from 6:30 a.m. until 2:00 p.m., Monday through Wednesday, and Friday.

October 19, 2001

A handwritten signature in black ink, consisting of a series of loops and a long horizontal stroke extending to the right.

**STELLA WOO
PRIMARY EXAMINER**